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Date: September 27, 2004

Re: U.S. Patent Application Serial No. 09/301,749

Dear Sir or Madam:

Enclosed is a Reply Brief in the pending Appeal.

Respectfully Submitted,


Jerome D. Jackson
Reg. No. 33,186

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PATENT

ATTORNEY DOCKET No. 104.012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Ken R. POWELL, Kevin W. Hartley,) Art Unit: 2165
Eleanor B. MAXWELL, and Corey C. SNOOK)
Serial No.: 09/301,749) Examiner: C. Nguyen
Filed : April 29, 1999)
For: COMPUTER SYSTEM CONFIGURATION)
AND METHOD FOR A STORE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY TO EXAMINER'S ANSWER

This is a Reply to the Examiner's Answer mailed August 3, 2004.

Claim Rejections - 35 U.S.C. § 102

The Examiner states:

The claimed system is similar as the system claimed by Powell Fig.14
since it already has full capabilities to perform all of these claimed
limitations. . . .

(Examiner's Answer page 3, emphasis added).

Appellant notes that being "similar" is insufficient for a rejection under § 102; identity is required. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (anticipation under § 102 requires that the "identical invention must be shown in as complete detail as is contained in the ... claim.") (emphasis added). "[E]lements [of the prior art reference] must be arranged as in the claim under review." *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Examiner continues:

... the system also includes a plurality of second processing units- (see Fig.14, ref. 952);, each second processing unit executing a second program in a second memory (see Fig.14, ref. 942), to determine a discount quantity (see 12:13-51) & see step 19060) (Examiner's Answer page 4, emphasis added).

Although the Examiner indicates that CPU 952 in Fig. 14 of the '278 Patent is the recited "second processing unit," this is not possible. CPU 952, executing instructions in card interface computer 920, cannot be the recited "second processing unit" because computer 920 does not "determine a discount quantity." Instead, computer 920 sends bar code data to its cash register computer 930. (The computer 930 then uses the bar code data to receive the discount from financial computer 800).¹

Claim Rejections - 35 U.S.C. § 103

The Examiner states:

It would be obvious to one of ordinary skilled in the art at the time of the invention to ascertain essential characteristics of cited reference and,

1. Appeal Brief page 12, line 8 et seq.

without departing from the spirit and scope thereof, can make modifications of Ken Power's reference to use that system in rearranging structures of a cash register to obtain "total amount due" after subtracting coupon amounts (employing multiple network interfaces at each cash register, and receiving signals from portable cards at each cash register) (Examiner's Answer page 13).

The Examiner states:


It is reasonable that a modification of previous Ken Power's invention would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of that invention because this application mainly claim the rearranging components in order to calculate a total amount due taking into account with signals from coupon amounts. Although cited invention may be described in connection with specific preferred embodiments, it should be understood that its limitations as disclosed should not be limited to such specific embodiments (Examiner's Answer page 16).

To make a rejection under § 103, the Examiner must show how is modifying '278 Patent to suggest Appellant's claims.

Although the Examiner's statements regarding § 103 are too general for Appellant to rebut, Appellant notes that the "mere fact that a prior art device could have been modified does not make modification obvious unless prior art suggested desirability of modification." *Cooper v. Ford Motor Co.*, 748 F.2d 677, 680, 223 U.S.P.Q. 1286 (Fed. Cir. 1984) citing *In re Gordon* 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). For example, it would not have been obvious to modify the bar code data, sent from computer 920 of the '278 Patent, to be the recited "discount quantity" determined by the "second processing unit," because this bar code

data is an emulation of data that computer 930 would normally see from an optically scanned paper coupon, allowing "a conventional supermarket checkout counter [to be] augmented with card interface computer 920, without requiring a change to the software of the conventional checkout counter." '278 Patent col. 8, lines 19-24.² See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Respectfully submitted,


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27 SEP 04

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2. See also '278 Patent Fig. 14 and col. 7, line 63 - col. 8, line 24.